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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,779	03/23/2004	John Gerard Speare	223566	2381

38887 7590 05/12/2005

LEYDIG, VOIT & MAYER, LTD.  
TWO PRUDENTIAL PLAZA, SUITE 4900  
180 NORTH STETSON  
CHICAGO, IL 60601-6780

EXAMINER
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ZHEN, WEI Y

ART UNIT	PAPER NUMBER
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2191

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/806,779

Applicant(s)

SPEARE ET AL.

Examiner

Wei Y. Zhen

Art Unit

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/18/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This Office Action is in response to the amendment filed on 12/6/2004.
2. Claims 1-27 are pending and remain rejected.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4, 6-9, 11-14, 16-18, 20-22, 24-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As per claims 1-4, 6-9, 11-14, 16-18, 20-22, 24-26 recite various steps for updating content in an electronic document. These steps can be done by a person as a mental step or using pencil and paper. These steps do not require the presence of hardware to be executed. Therefore, The claim limitations are directed merely to an abstract idea that is NOT tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2191

Claims 1, 3-6, 8-11, 13-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Donohue, U.S. Patent No. 6,202,207.

As per claim 1, Donohue discloses  
accepting the electronic document (col. 4 lines 50-54);  
determining whether the electronic document is subject to the persisted policy scheme (col. 5 lines 36-52);  
replacing a portion of the electronic document with an indicating piece of data (col. 5 lines 53-62).

As per claim 3, Donohue discloses determining and replacing are performed on a scheduled interval (col. 4 lines 40-44 and col. 6 lines 50-59).

As per claim 4, Donohue discloses determining and replacing are performed on an ad-hoc basis (col. 4 lines 40-44 and col. 6 lines 50-59).

Claim 5 is rejected for the reason set forth in the rejection of claim 1.

Claim 6 is rejected for the reason set forth in the rejection of claim 1.

Claim 8 is rejected for the reason set forth in the rejection of claim 3.

Claim 9 is rejected for the reason set forth in the rejection of claim 4.

Claim 10 is rejected for the reason set forth in the rejection of claim 6.

Claim 11 is rejected for the reason set forth in the rejection of claim 1.

Claim 13 is rejected for the reason set forth in the rejection of claim 3.

Claim 14 is rejected for the reason set forth in the rejection of claim 4.

Art Unit: 2191

Claim 15 is rejected for the reason set forth in the rejection of claim 11.

Claim 16 is rejected for the reason set forth in the rejection of claim 1.

Claim 17 is rejected for the reason set forth in the rejection of claim 3.

Claim 18 is rejected for the reason set forth in the rejection of claim 4.

Claim 19 is rejected for the reason set forth in the rejection of claim 16.

Claim 20 is rejected for the reason set forth in the rejection of claim 6.

Claim 21 is rejected for the reason set forth in the rejection of claim 3.

Claim 22 is rejected for the reason set forth in the rejection of claim 4.

Claim 23 is rejected for the reason set forth in the rejection of claim 6.

Claim 24 is rejected for the reason set forth in the rejection of claim 11.

Claim 25 is rejected for the reason set forth in the rejection of claim 3.

Claim 26 is rejected for the reason set forth in the rejection of claim 4.

Claim 27 is rejected for the reason set forth in the rejection of claim 11.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 7, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donohue,

U.S. Patent No. 6,202,207.

Art Unit: 2191

As per claim 2, Donohue does not explicitly disclose the electronic document is an electronic mail. Official Notice is taken that electronic mail was well known in the art at the time the invention was made. Therefore, it would have been obvious to one having ordinary skill in the art to incorporate the teaching of the well known knowledge into the teaching of Donohue to have the electronic document be an electronic mail because one would want to replace/update various types of software/data automatically and efficiently as taught by Donohue.

Claim 7 is rejected for the reason set forth in the rejection of claim 2.

Claim 12 is rejected for the reason set forth in the rejection of claim 2.

### ***Response to Arguments***

6. Applicant's arguments filed on have been fully considered but they are not persuasive.

In the remark, applicant has argued substantially as followed:

a) The claims are directed to updating "content in an electronic document".

Donohue is directed to updating or patching software (computer program). Donohue does not disclose updating "content in electronic document".

Examiner's response:

a) Examiner disagrees that Donohue does not disclose updating "content in electronic document". Examiner is interpreting a computer program has "content in electronic document".

Applicant has argued:

Art Unit: 2191

b) applicant's amendment claims require updating occurs on the content of an electronic document in accordance with the persisted policy. Content that has expired is deleted entirely, refreshed with more current content, or replaced with a tombstone indicating that the original content has expired. Such an arrangement is not described or even remotely suggested by the Donohue reference nor it is suggested by the combination of the Donohue reference with the statement in the office action of "official notice".

Examiner's response:

b) Donohue clearly disclose updating occurs on the content of an electronic documents in accordance with the persisted policy (col. 5 lines 36-62). Note that when software is upgraded, the old content is must be deleted and refreshed with more current content.

Applicant has argued:

c) Donohue does not teach any type of rights management application to electronic documents, but rather always results in the upgrading or patching of installed software.

Examiner's response:

c) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., type of rights management application to electronic documents) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Art Unit: 2191

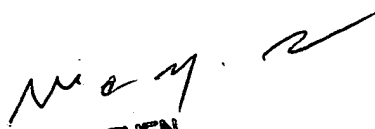
***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wei Y Zhen whose telephone number is (703) 305-0437. The examiner can normally be reached on Monday-Friday, 8 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wei Zhen  
Primary Examiner  
5/4/2005

  
**WEI Y. ZHEN**  
**PRIMARY EXAMINER**